

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain
Serial No. 10/824,226
Filed: 04/14/2004
For: **ADAPTIVE DIALING**

Examiner: Man U. Phan
Art Unit: 2619

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant encloses a payment in the amount of \$510.00 as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of record, i.e., Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-36 were rejected with the rejection made final on January 16, 2008.

Claims 4-11, 17, 22-29, and 35¹ were deemed allowable in the Final Office Action

¹ Claims 1, 2, 4, 11, 12, and 17 were objected to for containing "adapted to" language. The Patent Office has objected to the term "adapted to" as not being a positive limitation (Final Office Action mailed January 16, 2008, p. 4). However, the Patent Office has not yet addressed Appellant's arguments in the response filed October 30, 2007, in which Appellant argued that in the present case, the term "adapted to" is a positive limitation. Since the Patent Office has not addressed Appellant's arguments, Appellant reiterates and incorporates by reference its previous arguments (Response filed October 30, 2007, pp. 2-3). Appellant also notes that the "adapted to" language by itself cannot be objectionable. A search of the U.S. Patent Office database indicates that over 492,000 patents have been issued with the term "adapted to" in the claims. Appellant therefore respectfully maintains that the "adapted to" language is proper in the present case, and requests that the claims 1-36 be allowed.

mailed January 16, 2008 if rewritten in independent form; however, Appellant has not rewritten these claims in independent form.

Claims 1-36 are pending and are the subject of this appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of Appellant's knowledge. No amendments have been filed after the Final Office Action mailed January 16, 2008.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellant has noted where in the Specification certain subject matter exists. Appellant wishes to point out that these citations are for demonstrative purposes only and that the Specification may include additional discussion of the various elements, citations to which are not pointed out below. Thus, the noted citations are in no way intended to limit the scope of the pending claims.

Independent claim 1 recites a terminal (such as terminal 12, Figures 1 and 3) comprising:

a) at least one communication interface (various communication interfaces according to the present invention are disclosed in the Specification, including, but not limited to, receiver front end 50, baseband processor 58, and radio frequency transmitter 52 of Figure 3, which cooperate to form the wireless interface for the cellular network or the local wireless interface for the wireless access points 20, 24, 26, and 28, see Specification, paragraph 0035; or wired network interface 86, Figure 3) providing network connectivity to at least one communication network (such as access network 16 or 18, packet network 14, local area network 22, or PSTN 34, Figure 1); and

b) a control system (such as control system 60, Figure 3) associated with the at least one communication interface and adapted to:

i) determine a terminating address for a terminating party based on current network connectivity to the at least one communication network (Specification, paragraphs 0005, 0021-0029, 0031, and 0032; see also Figures 2A-2E); and

ii) initiate communications with the terminating party using the terminating address (Specification, paragraphs 0005 and 0021-0032; see also Figures 2A-2E).

Independent claim 19 recites a method comprising:

- a) determining network connectivity (Specification, paragraphs 0005, 0022, 0025-0029, 0031, and 0032; see also Figures 2A-2E);
- b) determining a terminating address for a terminating party based on the network connectivity to at least one communication network (such as access network 16 or 18, packet network 14, local area network 22, or PSTN 34, Figure 1) (Specification, paragraphs 0005, 0021-0029, 0031, and 0032; see also Figures 2A-2E); and
- c) initiating communications with the terminating party using the terminating address (Specification, paragraphs 0005 and 0021-0032; see also Figures 2A-2E).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1, 18, 19, and 36 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,999,770 B2 to Hirsbrunner et al. (hereinafter “Hirsbrunner”), given that Appellant filed declarations under 37 C.F.R. § 1.131 of the inventor and the attorney drafting the patent application to show that Appellant conceived of the present invention prior to Hirsbrunner and that diligent action was taken from a time prior to the filing of Hirsbrunner through the filing of the present application to constructively reduce the present invention to practice.

B. Whether claims 2, 3, 12-16, 20-24, and 30-34 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirsbrunner in view of U.S. Patent No. 7,099,306 B2 to Goodman et al. (hereinafter “Goodman”), given that Appellant filed declarations under 37 C.F.R. § 1.131 of the inventor and the attorney drafting the patent application to show that Appellant conceived of the present invention prior to Hirsbrunner and that diligent action was taken from a time prior to the filing of Hirsbrunner through the filing of the present application to constructively reduce the present invention to practice.

(7) ARGUMENT

A. Introduction

The claims of the present invention have been rejected over Hirsbrunner, either alone or in combination with Goodman. However, Hirsbrunner is not proper prior art under 35 U.S.C. § 102(e) because Appellant conceived of the present invention prior to Hirsbrunner. The Patent Office acted improperly by not considering the declarations filed by Appellant under 37 C.F.R. § 1.131 of the inventor and the attorney drafting the patent application to show that Appellant

conceived of the present invention prior to Hirsbrunner and that diligent action was taken from a time prior to the filing of Hirsbrunner through the filing of the present application to constructively reduce the present invention to practice. M.P.E.P. § 715 states that a declaration can be used under 37 C.F.R. § 1.131 to “antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e) where the reference has a prior art date under 35 U.S.C. § 102(e) prior to applicant’s effective filing date, and shows but does not claim the same patentable invention.” A declaration is inappropriate only if the reference claims the same invention that the present invention claims; i.e., the **claims** of the reference anticipate or render obvious the claimed invention. M.P.E.P. § 715.05.

In the present case, the claims of Hirsbrunner do not anticipate or render obvious the claimed invention, and thus a declaration under 37 C.F.R. § 1.131 is appropriate. With respect to claims 1, 18, 19, and 36, these claims are not anticipated or rendered obvious by the claims of Hirsbrunner. It is clear that the Patent Office has not provided any evidence that the claims of Hirsbrunner anticipate or render obvious claims 1, 18, 19, and 36. The Patent Office has not specifically cited where each of the limitations of the claimed invention are found in the claims of Hirsbrunner. In fact, the **claims** of Hirsbrunner do not anticipate or render obvious any of the claims of the present invention, as discussed in more detail below.

Because the Patent Office did not consider the declarations under 37 C.F.R. § 1.131, as should have been done, the rejections made in the Final Office Action mailed January 16, 2008 are improper, and the rejections must be withdrawn and the declarations considered. Once the declarations are considered, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e) because the date of invention for the present application was prior to the filing date of Hirsbrunner, and diligent action was taken from a time period prior to the filing date of Hirsbrunner, through the filing of the present application to constructively reduce the invention to practice. Therefore, Hirsbrunner is not prior art to the present application and the claims of the present application are allowable.

In addition, the Patent Office has already admitted that Hirsbrunner does not claim the same invention as the invention defined in claims 2, 3, 12-16, 20-24, and 30-34 of the present invention since the Patent Office relies on the combination of Goodman and Hirsbrunner in making a rejection under 35 U.S.C. § 103. Thus, it is clear that at least for claims 2, 3, 12-16, 20-24, and 30-34, Hirsbrunner alone does not claim the same invention as the present application. Accordingly, the declarations under 37 C.F.R. § 1.131 should be considered at least

with respect to claims 2, 3, 12-16, 20-24, and 30-34. Because the Patent Office did not consider the declarations under 37 C.F.R. § 1.131, as should have been done with respect to claims 2, 3, 12-16, 20-24, and 30-34, the rejections made in the Final Office Action mailed January 16, 2008 are improper, and the rejections must be withdrawn and the declarations considered. Once the declarations are considered, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e), as discussed above. Thus, the rejections of claims 2, 3, 12-16, 20-24, and 30-34 in view of Hirsbrunner and Goodman are improper and must be withdrawn.

As such, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

B. Summary Of References

1. U.S. Patent No. 6,999,770 B2 To Hirsbrunner

Hirsbrunner relates in general to wireless communication units and wireless networks, and more specifically to a method and apparatus for selectively routing or hairpinning calls through one such communication network while operating on another communication network (Hirsbrunner, col. 1, lines 6-10). In Hirsbrunner, a wireless communication unit selectively routes calls originated in one wireless communication network through another wireless communication network. The communication unit comprises a transceiver suitable to support an air interface with a first wireless communication network and with a second wireless communication network; a user interface operable to initiate a call to a number of a target unit; and a controller, coupled to the transceiver and the user interface, and operable, responsive to the call initiation and when the wireless communication unit is operating in the second wireless communication network, to selectively hairpin the call through the first communication network (Hirsbrunner, Abstract).

2. U.S. Patent No. 7,099,306 B2 To Goodman

Goodman discloses a system and method that provides for call completion of VoIP telephone calls (Goodman, Abstract). The method of Goodman comprises receiving a telephony advertisement packet comprising addressing information and storing the telephony advertisement packet. *Ibid.* The stored telephony advertisement packet is used to complete a call. *Ibid.*

C. Legal Standards

1. For Establishing Anticipation

Section 102 of the Patent Act provides the statutory basis for an anticipation rejection and states *inter alia*:

A person shall be entitled to a patent unless

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent** or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. . . (emphasis added).

M.P.E.P. § 715 states that a declaration can be used under 37 C.F.R. § 1.131 to “antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e) where the reference has a prior art date under 35 U.S.C. § 102(e) prior to applicant’s effective filing date, and shows but does not claim the same patentable invention.” A declaration is inappropriate only if the reference claims the same invention that the present invention claims; i.e., the **claims** of the reference anticipate or render obvious the claimed invention. M.P.E.P. § 715.05.

The Federal Circuit’s test for anticipation has been set forth numerous times. “It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). This standard has been reinforced. “To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1577 (Fed. Cir. 1996) (citations omitted). Further, “a finding of anticipation requires that the publication describe all of the elements of the claims, **arranged as in the patented device.**” *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted).

2. For Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 U.S.P.Q.2d (BNA) 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

D. Claims 1, 18, 19, And 36 Are Not Anticipated By Hirsbrunner Because Hirsbrunner Is Not Prior Art Under 35 U.S.C. § 102(e)

Claims 1, 18, 19, and 36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,999,770 B2 to Hirsbrunner et al. (hereinafter “Hirsbrunner”). Appellant respectfully traverses.

35 U.S.C. § 102(e) requires that the invention be “...described in (1) an application for patent, published under section 122(b), by another filed in the United States before the

invention by the applicant for patent” (emphasis added). However, Appellant conceived of the present invention prior to the filing date of Hirsbrunner, and constructively reduced the present invention to practice through the filing of the present application. As such, Hirsbrunner does not qualify as prior art under § 102(e).

In order to establish that Hirsbrunner does not qualify as prior art under § 102(e), Appellant refers to the previously submitted Declaration of the inventor, Dany Sylvain, under 37 C.F.R. § 1.131, which illustrates conception of the present invention prior to the filing date of Hirsbrunner. (See Exhibit 1). Appellant has also submitted the Declaration of Appellant’s representative, Benjamin S. Withrow, the patent attorney who drafted the present application, to be used in conjunction with the Declaration of the inventor, Dany Sylvain. (See Exhibit 2). These declarations show diligence from a time prior to the filing date of Hirsbrunner through a constructive reduction to practice of the present invention by the filing of the present application.

Based on the Declarations, Appellant asserts that the present invention was conceived of at least as early as December 5, 2003. Inventor Dany Sylvain conceived of the Present Invention at least as early as December 5, 2003, the date when Mr. Sylvain completed the Invention Disclosure and submitted it to the Intellectual Property Law Department at Nortel (See Exhibit 1, Declaration of Dany Sylvain, Paragraphs 3-5, and Appendix A). Appendix A to the Declaration of Dany Sylvain (hereinafter “Invention Disclosure”) clearly shows conception of each of the limitations of the present invention, as seen below with respect to representative claim 19²:

A method comprising:

- a) determining network connectivity (see Invention Disclosure, p. 2, Brief Description of Invention and Problem Solved by the Invention; see also Figure, p. 4, and Rough Claims, p. 5);
- b) determining a terminating address for a terminating party based on the network connectivity to at least one communication network (see Invention Disclosure, p. 2, Brief Description of Invention and Problem Solved by the Invention; see also Figure, p. 4, and Rough Claims, p. 5); and
- c) initiating communications with the terminating party using the terminating address (see Invention Disclosure, p. 2, Brief Description of Invention and Problem Solved by the Invention; see also Figure, p. 4, and Rough Claims, p. 5).

² Independent claim 1 is directed to a terminal, but has basically the same limitations as claim 19, and therefore was also conceived of at least as early as December 5, 2003, as shown in the Invention Disclosure.

Thus, as seen above, at least as early as December 5, 2003, before the December 30, 2003 filing date of Hirsbrunner, Mr. Sylvain had conceived of the invention claimed in the present application.

Further, the Declarations show that from a date prior to December 30, 2003 (the filing date of Hirsbrunner), diligent action was taken by Appellant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on April 14, 2004. (See Exhibit 2, Declaration of Benjamin S. Withrow, Paragraphs 3-14; and Exhibit 1, Declaration of Dany Sylvain, Paragraphs 5-12). In particular, prior to December 30, 2003, in-house patent attorney for the assignee of the present application reviewed the Invention Disclosure and approved it for discussion at the next scheduled Patent Review Committee meeting (See Exhibit 1, Declaration of Dany Sylvain, Paragraph 5). On January 9, 2004, at the next scheduled Patent Review Committee after the Invention Disclosure was received, the Patent Review Committee of the assignee of the present application reviewed the Invention Disclosure, made comments, and passed the Invention Disclosure back to the in-house patent attorney for the assignee. *Ibid.* Between January 9, 2004, and January 20, 2004, the in-house patent attorney reviewed the Invention Disclosure and the comments from the Patent Review Committee, and made a final decision to file a patent application seeking protection for the invention disclosed in the Invention Disclosure. *Ibid.* The in-house patent attorney for the assignee sent instructions on January 20, 2004 to Benjamin S. Withrow, registered U.S. patent attorney, Registration No. 40,876, of the law firm of Withrow & Terranova, PLLC, instructing him to prepare and file a patent application for the Invention Disclosure (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 3, and Appendix A; see also Exhibit 1, Declaration of Dany Sylvain, Paragraph 6 and Appendix B). Mr. Withrow also received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures prior to January 20, 2004 (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 5). From the time of receiving the instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures, until about April 14, 2004, Mr. Withrow worked to prepare patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 6).

Starting from January 20, 2004, and continuing through April 14, 2004, Mr. Withrow diligently reviewed the Invention Disclosure, spoke with the inventor Dany Sylvain, and diligently worked to prepare a patent application claiming the invention disclosed in the Invention Disclosure (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 7; see also Exhibit 1, Declaration of Dany Sylvain, Paragraph 7). The diligent work by Mr. Withrow resulted in a first draft of the Patent Application, which was sent to the inventor on February 26, 2004 (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 8 and Appendix B; see also Exhibit 1, Declaration of Dany Sylvain, Paragraph 8 and Appendix C). The inventor, Mr. Sylvain, then reviewed the draft application and provided minor comments regarding the First Draft to Mr. Withrow on March 12, 2004 (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 9 and Appendix C; see also Exhibit 1, Declaration of Dany Sylvain, Paragraph 9). On March 15, 2004, Mr. Withrow revised the Patent Application to incorporate the comments from the inventor and sent a revised Patent Application to in-house counsel at Nortel Networks Limited, the assignee (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 10 and Appendix C). A copy of the revised Patent Application, the inventor declaration, and the assignment document was also sent on March 15, 2004 to the inventor for his signature (see Exhibit 2, Declaration of Benjamin S. Withrow, Paragraph 11 and Appendix C; see also Exhibit 1, Declaration of Dany Sylvain, Paragraph 10). On April 14, 2004, after having received a signed inventor declaration and assignment document from the inventor, and approval from in-house counsel at Nortel Networks Limited to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on March 15, 2004, the Patent Application was filed with the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/824,226 (See Exhibit 2, Declaration of Benjamin S. Withrow, Paragraphs 12-14 and Appendix C; Exhibit 1, Declaration of Dany Sylvain, Paragraphs 11-12). Thus, from a date prior to December 30, 2003, the filing date of Hirsbrunner, diligent action was taken by Appellant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on April 14, 2004.

The filing date of the Hirsbrunner reference is December 30, 2003. Based on the declarations and the above facts, Appellant respectfully submits that the date of invention for the present application was prior to December 30, 2003 and that diligent action was taken from a time period prior to December 30, 2003, through the filing of the present application to

constructively reduce the invention to practice. Therefore, Hirsbrunner was not filed before Appellant's present invention. Thus, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1, 18, 19, and 36 as being anticipated by Hirsbrunner is improper and should be withdrawn.

In response to the declarations filed by Appellant under 37 C.F.R. § 1.131 of the inventor and the attorney drafting the patent application to show that Appellant conceived of the present invention prior to Hirsbrunner and that diligent action was taken from a time prior to the filing of Hirsbrunner through the filing of the present application to constructively reduce the present invention to practice, the Patent Office takes the position that a declaration under 37 C.F.R. § 1.131 is inappropriate in the present case because Hirsbrunner is claiming the same invention as the present invention and that the reference may be overcome only through an interference proceeding (Final Office Action mailed January 16, 2008, p. 2).³ Appellant respectfully disagrees.

M.P.E.P. § 715 states that a declaration can be used under 37 C.F.R. § 1.131 to "antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e) where the reference has a prior art date under 35 U.S.C. § 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention." A declaration is inappropriate only if the reference claims the same invention that the present invention claims; i.e., the **claims** of the reference anticipate or render obvious the claimed invention. M.P.E.P. § 715.05.

In the present case, the claims of Hirsbrunner do not anticipate or render obvious the claimed invention. With respect to claims 1, 18, 19, and 36, these claims are not anticipated or rendered obvious by the claims of Hirsbrunner. It is clear that the Patent Office has not provided any evidence that the claims of Hirsbrunner anticipate or render obvious claims 1, 18, 19, and 36. The Patent Office has not specifically cited where each of the limitations of the claimed invention are found in the claims of Hirsbrunner.⁴ In fact, the claims of Hirsbrunner do not anticipate or render obvious the claims of the present invention. For example, claim 1 of the present invention recites a terminal comprising:

a) at least one communication interface providing network connectivity to at least one communication network; and

³ The Patent Office cites to M.P.E.P. § 2306 in the Final Office Action (see Final Office Action mailed January 16, 2008, p. 2). However, M.P.E.P. § 2306 applies to interference proceedings. The relevant M.P.E.P. section is M.P.E.P. § 715.

⁴ The Patent Office has never referred to the **claims** of Hirsbrunner in any of the Office Actions.

b) a control system associated with the at least one communication interface and adapted to:

- i) determine a terminating address for a terminating party based on current network connectivity to the at least one communication network; and
- ii) initiate communications with the terminating party using the terminating address.

Claim 19 has similar limitations as those found in claim 1.

In contrast, claim 1 of Hirsbrunner recites a wireless communication unit comprising:
a transceiver suitable to support an air interface with a first wireless communication network and with a second wireless communication network;
a user interface operable to initiate a call to a number of a target unit;
and a controller, coupled to the transceiver and the user interface, and operable, responsive to the call initiation and when the wireless communication unit is operating in the second wireless communication network, to selectively hairpin the call through the first communication network, wherein the controller, to selectively hairpin, is: further operable to determine when the call is likely to be handed into the first communication network; and further operable, if the call is likely to be handed into the first communication network, to hairpin the call through the first communication network.

Noticeably absent from claim 1 of Hirsbrunner are the limitations of **determining a terminating address for a terminating party based on current network connectivity to the at least one communication network** and initiating communications with the terminating party using the terminating address, which are found in claim 1 of the present invention. None of the remaining claims of Hirsbrunner include the limitations of **determining a terminating address for a terminating party based on current network connectivity to the at least one communication network** and initiating communications with the terminating party using the terminating address, which are found in claim 1 of the present invention. Thus, the claims of Hirsbrunner do not anticipate or render obvious the present claimed invention. Since the claims of Hirsbrunner do not anticipate or render obvious the present claimed invention, Hirsbrunner does not claim the same invention as the present application. Since Hirsbrunner does not claim the same invention as the present application, a declaration under 37 C.F.R. § 1.131 is appropriate and may be used. Because the Patent Office did not consider the declarations under

37 C.F.R. § 1.131 as they should have, the Final Office Action mailed January 16, 2008 is improper.

Based on the declarations and the facts and arguments previously set forth in Appellant's response filed October 30, 2007, Appellant respectfully submits that the date of invention for the present application was prior to the filing date of Hirsbrunner and that diligent action was taken from a time period prior to the filing date of Hirsbrunner, through the filing of the present application, to constructively reduce the invention to practice. Therefore, Hirsbrunner was not filed before Appellant's present invention. Thus, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1, 18, 19, and 36 as being anticipated by Hirsbrunner is improper and should be withdrawn.

E. Claims 2, 3, 12-16, 20-24, and 30-34 Are Not Obvious Over Hirsbrunner In View Of Goodman

Claims 2, 3, 12-16, 20-24, and 30-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirsbrunner in view of U.S. Patent No. 7,099,306 B2 to Goodman et al. (hereinafter "Goodman"). Appellant respectfully traverses.

Since Hirsbrunner is not available as prior art under 35 U.S.C. § 102(e), as discussed above, the rejection of claims 2, 3, 12-16, 20-24, and 30-34 over Hirsbrunner and Goodman is also improper and must be withdrawn.

In response to the Patent Office's position that the declarations are inappropriate under 37 C.F.R. § 1.131, as discussed above, M.P.E.P. § 715 states that a declaration can be used under 37 C.F.R. § 1.131 to "antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e) where the reference has a prior art date under 35 U.S.C. § 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention." A declaration is inappropriate only if the reference claims the same invention that the present invention claims; i.e., the **claims** of the reference anticipate or render obvious the claimed invention. M.P.E.P. § 715.05.

In the present case, the claims of Hirsbrunner do not anticipate or render obvious the claimed invention. In fact, the Patent Office has admitted this for claims 2, 3, 12-16, 20-24, and 30-34 since the Patent Office relies on Goodman as a secondary reference. Because the Patent Office relies on Goodman as part of a rejection under 35 U.S.C. §103, the Patent Office is admitting that **the claims of Hirsbrunner alone** do not anticipate or render obvious claims 2, 3,

12-16, 20-24, and 30-34 of the claimed invention. Thus, it is clear that at least for claims 2, 3, 12-16, 20-24, and 30-34, Hirsbrunner does not claim the same invention as the present application. Accordingly, the declarations under 37 C.F.R. § 1.131 should be considered at least with respect to claims 2, 3, 12-16, 20-24, and 30-34. Because the Patent Office did not consider the declarations under 37 C.F.R. § 1.131 as should have been done with respect to claims 2, 3, 12-16, 20-24, and 30-34, the Final Office Action mailed January 16, 2008 is improper. Once the declarations are properly considered, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e), and the rejections of claims 2, 3, 12-16, 20-24, and 30-34 in light of Hirsbrunner and Goodman must be withdrawn.

F. Conclusion

Hirsbrunner is not proper prior art under 35 U.S.C. § 102(e) because Appellant conceived of the present invention prior to Hirsbrunner. The Patent Office has acted improperly by not considering the declarations filed by Appellant under 37 C.F.R. § 1.131 of the inventor and the attorney drafting the patent application to show that Appellant conceived of the present invention prior to Hirsbrunner and that diligent action was taken from a time prior to the filing of Hirsbrunner through the filing of the present application to constructively reduce the present invention to practice. A declaration under 37 C.F.R. § 1.131 is inappropriate only if the reference claims the same invention that the present invention claims; i.e., the **claims** of the reference anticipate or render obvious the claimed invention. M.P.E.P. § 715.05.

In the present case, the claims of Hirsbrunner do not anticipate or render obvious the claimed invention. With respect to claims 1, 18, 19, and 36, these claims are not anticipated or rendered obvious by the claims of Hirsbrunner. It is clear that the Patent Office has not provided any evidence that the claims of Hirsbrunner anticipate or render obvious claims 1, 18, 19, and 36. The Patent Office has not specifically cited where each of the limitations of the claimed invention are found in the claims of Hirsbrunner. In fact, the **claims** of Hirsbrunner do not anticipate or render obvious any of the claims of the present invention. With respect to claims 2, 3, 12-16, 20-24, and 30-34, the Patent Office has already admitted that Hirsbrunner does not claim the same invention as the invention defined in claims 2, 3, 12-16, 20-24, and 30-34 of the present invention since the Patent Office relies on the combination of Goodman and Hirsbrunner in making a rejection under 35 U.S.C. § 103.

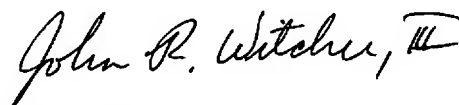
Because the Patent Office did not consider the declarations under 37 C.F.R. § 1.131, as should have been done, the rejections made in the Final Office Action mailed January 16, 2008 are improper. Once the declarations are considered, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e) because the date of invention for the present application was prior to the filing date of Hirsbrunner, and diligent action was taken from a time period prior to the filing date of Hirsbrunner, through the filing of the present application to constructively reduce the invention to practice. Therefore, Hirsbrunner is not prior art to the present application and the claims of the present application are allowable.

As such, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III
Registration No. 39,877
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: June 16, 2008
Attorney Docket: 7000-341

(8) CLAIMS APPENDIX

1. A terminal comprising:
 - a) at least one communication interface providing network connectivity to at least one communication network; and
 - b) a control system associated with the at least one communication interface and adapted to:
 - i) determine a terminating address for a terminating party based on current network connectivity to the at least one communication network; and
 - ii) initiate communications with the terminating party using the terminating address.
2. The terminal of claim 1 wherein a plurality of addresses corresponding to different types of network connectivity are associated with the terminating party, such that different ones of the plurality of addresses correspond to different ones of the types of network connectivity, and to determine the terminating address the control system is further adapted to:
 - a) determine the current network connectivity available for the communications with the terminating party; and
 - b) select the terminating address from the plurality of addresses based on the current network connectivity.
3. The terminal of claim 2 wherein at least two of the plurality of addresses are of the group consisting of a public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, packet network address, uniform resource locator address, and session initiation protocol address.
4. The terminal of claim 1 wherein different formats of the terminating address correspond to different types of network connectivity, and to determine the terminating address, the control system is further adapted to:
 - a) determine the network connectivity to use for the communications with the terminating party; and

b) provide a select format of the terminating address from the different formats based on the network connectivity, wherein the select format of the terminating address is used to initiate the communications with the terminating party.

5. The terminal of claim 4 wherein to provide the select format of the terminating address, the control system is further adapted to modify a primary format of the terminating address to provide the select format.

6. The terminal of claim 5 wherein the primary format of the terminating address is modified by removing a prefix from the terminating address.

7. The terminal of claim 5 wherein the primary format of the terminating address is modified by adding a prefix to the terminating address.

8. The terminal of claim 5 wherein the primary format of the terminating address is modified by replacing a portion of the terminating address.

9. The terminal of claim 5 wherein the primary format of the terminating address is modified by removing a portion of the terminating address.

10. The terminal of claim 5 wherein the primary format of the terminating address is modified by adding a portion to the terminating address.

11. The terminal of claim 1 wherein the at least one communication interface is adapted to facilitate a plurality of different types of network connectivity, and different terminating addresses or different terminating address formats are used to initiate communications with the terminating party, the control system further adapted to determine the network connectivity to initiate communications with the terminating party and determine the terminating address by either:

a) selecting one of a plurality of addresses associated with the terminating party as the terminating address based on the network connectivity, or

b) modifying an address associated with the terminating party to use as the terminating address based on the network connectivity.

12. The terminal of claim 1 further comprising a user interface associated with the control system, which is further adapted to select the terminating party based on input received from a user via the user interface.

13. The terminal of claim 12 wherein the input specifies a name of the terminating party.

14. The terminal of claim 12 wherein the input specifies a location or terminal associated with the terminating party.

15. The terminal of claim 12 wherein the input specifies the terminating party from a list of a plurality of parties.

16. The terminal of claim 12 wherein the input selects the terminating party from a call log.

17. The terminal of claim 1 wherein the control system is adapted to:

- a) support a plurality of originating IDs for a user;
- b) select one of the plurality of originating IDs to use in association with initiating the communications with the terminating party;
- c) determine the terminating address for the terminating party based on the one of the plurality of originating IDs as well as the network connectivity to the at least one communication network.

18. The terminal of claim 1 wherein the network connectivity corresponds to facilitating communications with a supporting network consisting of at least one of the group consisting of a cellular network, any local wireless network, a specific local wireless network, any local wireless access point, a specific local wireless access point, any local area network, a specific local area network, and a public switched telephone network.

19. A method comprising:

- a) determining network connectivity;
- b) determining a terminating address for a terminating party based on the network connectivity to at least one communication network; and
- c) initiating communications with the terminating party using the terminating address.

20. The method of claim 19 wherein a plurality of addresses corresponding to different types of network connectivity are associated with the terminating party, such that different ones of the plurality of addresses correspond to different ones of the types of network connectivity, and to determine the terminating address, the method further comprising selecting the terminating address from the plurality of addresses based on the network connectivity.

21. The method of claim 20 wherein at least two of the plurality of addresses are of the group consisting of a public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, packet network address, uniform resource locator address, and session initiation protocol address.

22. The method of claim 19 wherein different formats of the terminating address corresponding to different types of network connectivity, and to determine the terminating address, the method further comprises providing a select format of the terminating address from the different formats based on the network connectivity, wherein the select format of the terminating address is used to initiate communications with the terminating party.

23. The method of claim 22 wherein to provide the select format of the terminating address, the method further comprises modifying a primary format of the terminating address to provide the select format.

24. The method of claim 23 wherein the primary format of the terminating address is modified by removing a prefix from the terminating address.

25. The method of claim 23 wherein the primary format of the terminating address is modified by adding a prefix to the terminating address.

26. The method of claim 23 wherein the primary format of the terminating address is modified by replacing a portion of the terminating address.
27. The method of claim 23 wherein the primary format of the terminating address is modified by removing a portion of the terminating address.
28. The method of claim 23 wherein the primary format of the terminating address is modified by adding a portion to the terminating address.
29. The method of claim 19 wherein a plurality of different types of network connectivity are possible, and different terminating addresses or different terminating address formats are used to initiate communications to the terminating party, the method further comprising determining the terminating address by either:
- a) selecting one of a plurality of addresses associated with the terminating party as the terminating address based on the network connectivity, or
 - b) modifying an address associated with the terminating party to use as the terminating address based on the network connectivity.
30. The method of claim 19 further comprising selecting the terminating party based on input received from a user via a user interface.
31. The method of claim 30 wherein the input specifies a name of the terminating party.
32. The method of claim 30 wherein the input specifies a location or terminal associated with the terminating party.
33. The method of claim 30 wherein the input specifies the terminating party from a list of a plurality of parties.
34. The method of claim 30 wherein the input selects the terminating party from a call log.

35. The method of claim 19 wherein the method further comprises:

- a) supporting a plurality of originating IDs for a user;
- b) selecting one of the plurality of originating IDs to use in association with initiating the communications with the terminating party;
- c) determining the terminating address for the terminating party based on the one of the plurality of originating IDs as well as the network connectivity to the at least one communication network.

36. The method of claim 19 wherein the network connectivity corresponds to facilitating communications with a supporting network consisting of at least one of the group consisting of a cellular network, any local wireless network, a specific local wireless network, any local wireless access point, a specific local wireless access point, any local area network, a specific local area network, and a public switched telephone network.

(9) EVIDENCE APPENDIX

Appellant attaches herewith as Exhibit 1, a copy of a Declaration under 37 C.F.R. § 1.131 of Dany Sylvain, the inventor of the present invention, which was filed on October 30, 2007.

Appellant also attaches herewith as Exhibit 2, a copy of a Declaration under 37 C.F.R. § 1.131 of Benjamin S. Withrow, the patent attorney who drafted the present application, which was also filed on October 30, 2007.

(10) RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, this appendix is not applicable.

Exhibit 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain
Serial No. 10/824,226
Filed: 04/14/2004
For: **ADAPTIVE DIALING**

Examiner: Man U. Phan
Art Unit: 2616

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION UNDER 37 C.F.R. § 1.131 OF DANY SYLVAIN

1. My name is Dany Sylvain and I am an employee of Nortel Networks, Inc. (hereinafter "Nortel"), a wholly owned subsidiary of the assignee of the present application. I have been employed by Nortel since 1981. As part of my obligations under my Employment Agreement, I am obligated to assign any rights to inventions to the present assignee.
2. I am the inventor of Patent Application Serial No. 10/824,226 entitled "ADAPTIVE DIALING" (hereinafter "Patent Application").
3. I have reviewed claims 1-36 presently pending in the Patent Application (hereinafter "Present Invention").
4. At least as early as December 5, 2003, I conceived of the Present Invention as evidenced by the Invention Disclosure entitled "Adaptive Dialing," which is attached to this Declaration as Appendix A.
5. On December 5, 2003, I completed the Invention Disclosure and submitted it to the Intellectual Property Law Department at Nortel. Prior to December 30, 2003, Rick Witcher, in-house patent attorney for Nortel, reviewed the Invention Disclosure and approved it for discussion at the next scheduled Patent Review Committee meeting. On January 9, 2004, at the next scheduled Patent Review Committee after the Invention Disclosure was submitted, the Patent Review Committee reviewed the Invention Disclosure, made comments, and passed the Invention Disclosure back to the in-house patent attorney. Between January 9, 2004, and

January 20, 2004, the in-house patent attorney reviewed the Invention Disclosure and the comments from the Patent Review Committee, and made a final decision to file a patent application seeking protection for the invention disclosed in the Invention Disclosure.

6. On or about January 20, 2004, I received a copy of a memo from the in-house patent attorney of Nortel, which is attached as Appendix B, that instructed Benjamin S. Withrow of the law firm of Withrow & Terranova, PLLC to prepare and file a patent application for the Invention Disclosure.

7. From a period beginning soon after January 20, 2004, and continuing through April 14, 2004, I met with the attorney Benjamin S. Withrow and worked with him to prepare the Patent Application claiming the invention disclosed in the Invention Disclosure.

8. On February 26, 2004, I received a first draft of the Patent Application (hereinafter "First Draft") from Benjamin S. Withrow's assistant, Jennifer Alkove, as evidenced by the e-mail attached to this Declaration as Appendix C.

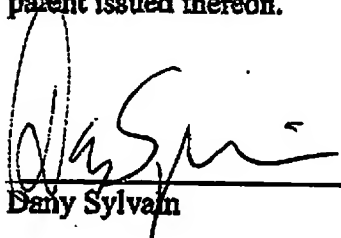
9. Between February 26, 2004, and March 12, 2004, I reviewed the First Draft. On or about March 12, 2004, I sent minor comments to Benjamin S. Withrow regarding the First Draft.

10. On or about March 15, 2004, I received a copy of a revised Patent Application and the inventor declaration and assignment documents from Benjamin S. Withrow's assistant, Jennifer Alkove.

11. On or about March 19, 2004, I returned the signed inventor declaration and assignment document to the attorney, Benjamin S. Withrow.

12. Upon information and belief, the Patent Application was filed with the U.S. Patent and Trademark Office on April 14, 2004.

13. I hereby declare that all declarations made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Dany Sylvain

29/10/07
Date

Appendix A

Invention Disclosure Submission Reply

DEC - 5 2003

Disc No:		Received Date:	05 dec 2003
Disc Title:	Adaptive dialing		

----- Inventors -----

Global ID	Name	Work Info	Home Info
150485 1	HR Name: SYLVAIN, DANY Known As: DANY Email: Mgr First Name: STEPHEN Mgr Last Name: ELLIOTT Mgr Global ID:	Location: Location Code: Dept: Phone: Ext Phone: Fax: Ext Fax: MailStop: Citizenship:	Address: Phone:

----- Attachments -----

File Name	File Type	File Comment
adaptive_dialing_2.ppt	Microsoft Powerpoint (*.ppt)	

<End of Attachments>

Were there additional inventors involved?	no	Was there contractor involvement?	no
Name of Supervisor or Divisional Head		Name of V.P.	
STEVE ELLIOTT		SUE SPRADLEY	
Job	WIRELIN NETWORKS**	Business Unit	CTL/VOIP
Contribution Date:			
Has this invention been discussed with others? If so, please complete:			
Inside Nortel - Whom?		Outside Nortel - Whom?	
Inside Nortel - When?		Outside Nortel - When?	
END OF			
no			
Are you aware of any imminent future disclosures? Please provide dates and details.			

Keywords for Searching:		Products that will use this invention:	
Dialing, dual mode handset, location			
Does this invention arise from any arrangement involving an external organization?			no
Is this invention relevant to a Standards Activity?			Internal Funding Project #s:
no			
Provide details:			

Technical Information

Brief Description of the Invention:

- Automatically selecting an address for a terminating party based on the originator network connectivity
 - Network connectivity is cellular network
 - Network connectivity is WLAN/Bluetooth network
 - Network connectivity is a specific WLAN/Bluetooth access point
- Selection is done by specifying a terminating party name
- Selection is one of multiple address entries for a terminating party
- Address entry is one of
 - public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, sip address, url address
- Modifying the selected address based on originator network connectivity
 - Adding a prefix, removing a prefix
 - Substituting a portion of the address
- Querying a service node for the public E.164 alias for a sip address entry, storing the public E.164 address in association with the sip address entry

Problem Solved by the Invention:

Dual mode handsets can initiate calls from various locations: cellular network, from an enterprise WLAN network, from home. Depending on those locations, the number that needs to be dialed will vary. A typical problem is the local personal directory for the handset contains entries for frequently dialed numbers. If the user is an enterprise user, the entries may contain the ESN number of colleagues or the 4-digit extension number. When dialing from the enterprise WLAN zone, the ESN or 4-digit number will work fine. However, if it's used on the cellular network these numbers won't work.

To get around this issue, this invention proposes two options: store multiple entries for the user and let the handset automatically select the appropriate entry based on the current network connectivity. The second option consists in altering the stored number based on pre-established rules, such as translating an ESN number to a public number using a local map.

A second problem solved is automating the process of retrieving an E.164 alias for a SIP address.

Solutions that have been tried and why they did not work:

Modem dialers allow the selection of various prefix (e.g. 9) based on user location: users need to manually select the prefix; no address substitution or modification is done

Multiple numbers can be stored in a personal directory for a same user: again the caller needs to select manually the entry.

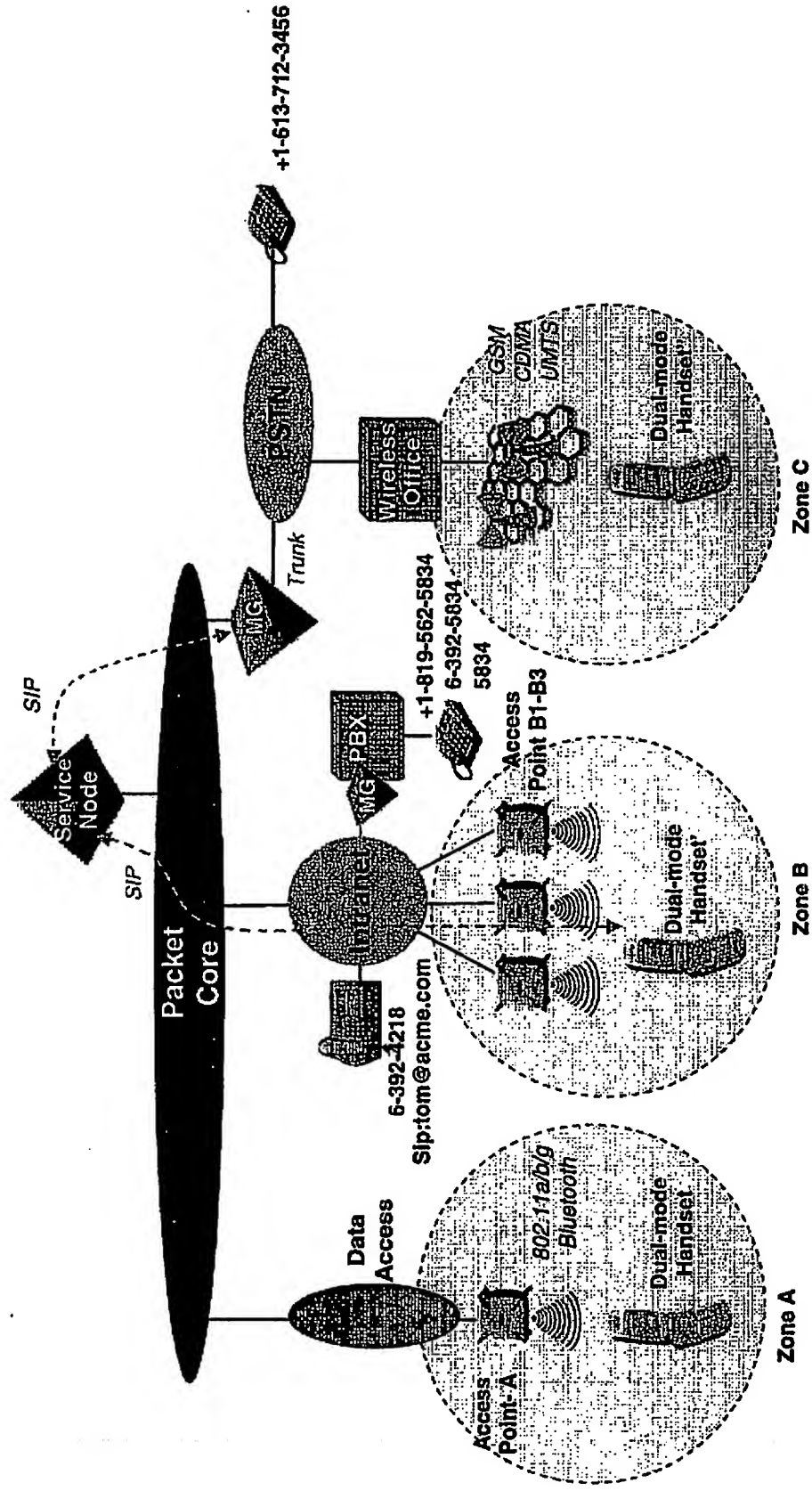
Specific elements or steps that solved the problem and how they do it:

See chart for some additional details

Commercial value of the invention of Nortel and Nortel's main competitors

This problem surfaced during the definition of the dual mode handset system solution (personal mobile communicator). This invention, although easy to implement, will significantly improve the usability of PMC, a critical factor for market acceptance. In addition, by automating the translation of sip addresses to E.164 aliases, this will also make it easier for users to start using sip addresses as the main address for users (the E.164 being the backup one), helping accelerating the transition to sip addresses, a more natural form of addressing for users.

Network



Rough claims

- **Automatically selecting an address for a terminating party based on the originator network connectivity**
 - Network connectivity is cellular network
 - Network connectivity is WLAN/Bluetooth network
 - Network connectivity is a specific WLAN/Bluetooth access point
- **Selection is done by specifying a terminating party name**
- **Selection is one of multiple address entries for a terminating party**
 - Address entry is one of public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, sip address, url address
- **Modifying the selected address based on originator network connectivity**
 - Adding a prefix, removing a prefix
 - Substituting a portion of the address
- **Querying a service node for the public E.164 alias for a sip address entry, storing the public E.164 address in association with the sip address entry**

Appendix B

7880-341

NORTEL NETWORKS

www.nortelnetworks.com

John R. Witcher, III
Senior Counsel

**NORTEL NETWORKS CONFIDENTIAL &
PRIVILEGED COMMUNICATION**

January 20, 2004

VIA FEDERAL EXPRESS

Mr. Benjamin Withrow, Esq.
Withrow & Terranova
201 Shannon Oaks Circle
Suite 200
Cary, NC 27511

Re: Invention Docket No.:
 Title: *Adaptive Dialing*

Dear Ben:

Nortel Networks would like to retain you to prepare and file in the United States Patent and Trademark Office (USPTO) a patent application directed to the invention disclosed in the enclosed invention disclosure by the above-referenced filing date. The application should be prepared according to Nortel Networks guidelines in accordance with the predetermined fee we have agreed with your firm. If you are unable to perform the requested work, please advise me immediately.

In addition to the invention disclosure, an invention disclosure Review Summary document is enclosed for your consideration. We request that you contact the primary inventor, Dany Sylvain, at _____ within two weeks of receiving this letter. Please ensure that the inventor(s) are advised of their responsibilities regarding their duty of candor to the USPTO, as well as any other relevant rules and/or laws including the best mode requirement.

Questions pertaining to substantive issues associated with the application should be addressed with me, while administrative issues associated with the application should be addressed with Theresa Boyce. Please be sure that all communications associated with the application, including billing statements and the application itself bear the above-referenced disclosure number.

Please send a substantially complete and final draft of the application to me along with a completed Nortel Networks Outsource's Patent Application Checklist at least 10 days prior to the above-referenced filing date to provide Nortel Networks' Intellectual Property Law Group sufficient opportunity to review the application prior to filing. You should seek to obtain the signatures on the formal papers from all inventors directly.

**Please confirm receipt of this disclosure via facsimile to the above-identified number.
Please include your assigned reference number.**

Upon filing the application with the USPTO, immediately fax a copy of the application transmittal letter to me, so that we have a record that the application has been filed. Thereafter, please send me a hardcopy of the application as filed along with an electronic copy in Microsoft Word 6.0 readable format on a 3 1/2" floppy disk.

Should you have any questions, please call me at

Very truly yours,



Rick Witcher

Enclosures: Invention Disclosure No.:
Review Summary
Patent Application Outsource Checklist

JRW:slw

cc: Dany Sylvain

Appendix C

Jennifer Alkove

From: Jennifer Alkove
Sent: Thursday, February 26, 2004 11:50 AM
To: 'sylvain@nortelnetworks.com'
Cc: Ben Withrow
Subject: First Draft of (our file 7000-341)



First Draft.zip (...)

Suspicious files were found in the attachments.

The file First Draft.zip: Contains password-protected files

The original message follows:

Dear Dany:

Please find attached a first draft of the above-referenced patent application. The .zip file is protected with the password that we have used in previous applications. If you have any problems opening the attached file, please let me know. Please review the application and drawings carefully for accuracy and completeness, making any changes, additions, or corrections, if any, directly on the application (or electronically with changes tracked).

Please recall that the application must clearly explain the best mode of practicing the invention for which protection is desired. Also, the application must explain to an individual of ordinary skill in the art how to make and use the invention. After reviewing the application, please forward any comments to Ben Withrow and me. We will then send you a revised draft of the application, along with formal paperwork prepared for your signature. After receipt of the signed paperwork and approval from Nortel's legal department, we will file the application.

Please do not hesitate to contact Ben Withrow or me should you have any questions regarding the application. Thank you for allowing us to be of service to you and for your prompt attention to this matter.

Best regards,

Jennifer Rush Alkove

Withrow & Terranova, PLLC

201 Shannon Oaks Circle, Suite 200

Cary, NC 27511

Ph: 919-654-4570 Fax: 919-654-4521

WARNING! This message may contain information that is confidential and/or protected under the attorney-client or other lawfully recognized privilege. If you received this message in error or through inappropriate means, please REPLY to this message to notify the Sender that the message erroneously was received by you, and then permanently delete this message from all storage media, without forwarding or retaining a copy.

Checked by AVG Free Edition.

Version: 7.5.503 / Virus Database: 269.15.12/1097 - Release Date: 10/28/2007 1:58 PM

Exhibit 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain
Serial No. 10/824,226
Filed: 04/14/2004
For: **ADAPTIVE DIALING**

Examiner: Man U. Phan
Art Unit: 2616

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION UNDER 37 C.F.R. § 1.131 OF BENJAMIN S. WITHROW

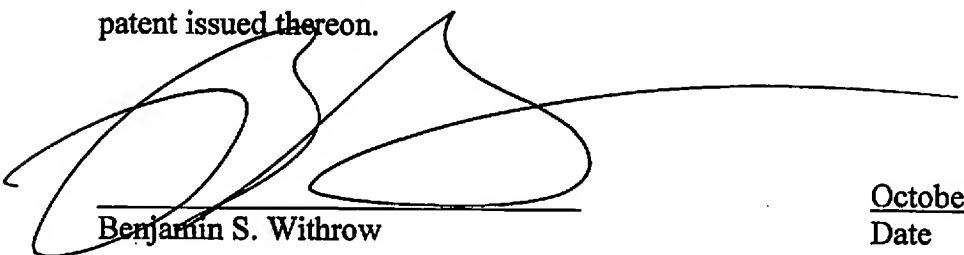
1. My name is Benjamin S. Withrow of the law firm of Withrow & Terranova, PLLC, and I am a registered U.S. patent attorney, Registration No. 40,876.
2. Starting in 2000, and continuing until the present time, I have been retained as outside counsel for Nortel Networks Limited (hereinafter "Nortel"), the assignee of the present application.
3. On or about January 20, 2004, I received instructions from Nortel to prepare and file a patent application for an Invention Disclosure entitled "Adaptive Dialing," which is attached to this Declaration as Appendix A (hereinafter "Invention Disclosure"). This Invention Disclosure was assigned attorney docket number 7000-341.
4. The Invention Disclosure was submitted by the inventor, Dany Sylvain, on December 5, 2003.
5. Prior to January 20, 2004, I received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures.
6. From the time of receiving instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures until about April 14, 2004, I worked to prepare

patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion.

7. Starting from a period soon after January 20, 2004, and continuing through April 14, 2004, I diligently reviewed the Invention Disclosure, met with the inventor Dany Sylvain, and diligently worked to prepare a patent application (hereinafter "Patent Application") claiming the invention disclosed in the Invention Disclosure.
8. On February 26, 2004, my assistant, Jennifer Alkove, sent a first draft of the Patent Application (hereinafter "First Draft") to the inventor, as evidenced by the e-mail attached to this Declaration as Appendix B.
9. On March 12, 2004, I received minor comments from the inventor regarding the First Draft, as evidenced by the excerpt from a spreadsheet attached to this declaration as Appendix C.
10. On March 15, 2004, I revised the Patent Application to incorporate the comments from the inventor for the First Draft, and sent a revised Patent Application to in-house counsel at Nortel, as evidenced by the spreadsheet attached to this declaration as Appendix C.
11. On March 15, 2004, my assistant, Jennifer Alkove, sent a copy of the revised Patent Application and the inventor declaration and assignment document to the inventor to be signed, as evidenced by the spreadsheet attached to this declaration as Appendix C.
12. On March 19, 2004, I received a signed inventor declaration and assignment document from the inventor, as evidenced by the spreadsheet attached to this declaration as Appendix C.
13. On April 13, 2004, I received approval from in-house counsel at Nortel to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on March 19, 2004, as evidenced by the spreadsheet attached to this declaration as Appendix C.

14. On April 14, 2004, the Patent Application was filed with the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/824,226.

15. I hereby declare that all declarations made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Benjamin S. Withrow

October 30, 2007
Date

Appendix A

7000-341

NORTEL NETWORKS

www.nortelnetworks.com

John R. Witcher, III
Senior Counsel

**NORTEL NETWORKS CONFIDENTIAL &
PRIVILEGED COMMUNICATION**

January 20, 2004

VIA FEDERAL EXPRESS

Mr. Benjamin Withrow, Esq.
Withrow & Terranova
201 Shannon Oaks Circle
Suite 200
Cary, NC 27511

Re: Invention Docket No.:
Title: *Adaptive Dialing*

Dear Ben:

Nortel Networks would like to retain you to prepare and file in the United States Patent and Trademark Office (USPTO) a patent application directed to the invention disclosed in the enclosed invention disclosure by the above-referenced filing date. The application should be prepared according to Nortel Networks guidelines in accordance with the predetermined fee we have agreed with your firm. If you are unable to perform the requested work, please advise me immediately.

In addition to the invention disclosure, an invention disclosure Review Summary document is enclosed for your consideration. We request that you contact the primary inventor, Dany Sylvain, at _____ within two weeks of receiving this letter. Please ensure that the inventor(s) are advised of their responsibilities regarding their duty of candor to the USPTO, as well as any other relevant rules and/or laws including the best mode requirement.

Questions pertaining to substantive issues associated with the application should be addressed with me, while administrative issues associated with the application should be addressed with Theresa Boyce. Please be sure that all communications associated with the application, including billing statements and the application itself bear the above-referenced disclosure number.

Please send a substantially complete and final draft of the application to me along with a completed Nortel Networks Outsource's Patent Application Checklist at least 10 days prior to the above-referenced filing date to provide Nortel Networks' Intellectual Property Law Group sufficient opportunity to review the application prior to filing. You should seek to obtain the signatures on the formal papers from all inventors directly.

**Please confirm receipt of this disclosure via facsimile to the above-identified number.
Please include your assigned reference number.**

Upon filing the application with the USPTO, immediately fax a copy of the application transmittal letter to me, so that we have a record that the application has been filed. Thereafter, please send me a hardcopy of the application as filed along with an electronic copy in Microsoft Word 6.0 readable format on a 3 1/2" floppy disk.

Should you have any questions, please call me at

Very truly yours,



Rick Witcher

Enclosures: Invention Disclosure No.:
 Review Summary
 Patent Application Outsource Checklist

JRW:slw

cc: Dany Sylvain

Invention Disclosure Submission Reply

DEC - 5 2003

Disc No:		Received Date:	05 dec 2003
Disclosure Title:	Adaptive dialing		

----- Inventors -----

Global ID	Name	Work Info	Home Info
150485 1	HR Name: SYLVAIN, DANY Known As: DANY Email: Mgr First Name: STEPHEN Mgr Last Name: ELLIOTT Mgr Global ID:	Location: Location Code: Dept: Phone: Ext Phone: Fax: Ext Fax: MailStop: Citizenship:	Address: Phone:

----- Attachments -----

File Name	File Type	File Comments
adaptive_dialing_2.ppt	Microsoft Powerpoint (*.ppt)	

<End of Attachments>

Were there additional inventors involved?	no	Was there confidential involvement?	no
Name of Supervisor or Divisional Head	Name of VP		
STEVE ELLIOTT		SUE SPRADLEY	
LOB	WIRELINE NETWORKS**	Business Unit	CTL/VOIP
Contention Date			
Has this invention been discussed with others? If so, please complete:			
Inside Nortel - Whom?		Outside Nortel - Whom?	
Inside Nortel - When?		Outside Nortel - When?	
NDAA	no		
Are you aware of any imminent future disclosures? Please provide dates and details.			

Keywords for Searching:		Products that will use this invention:	
Dialing, dual mode handset, location			
Does this invention arise from an arrangement involving an external organization?			no
Is this invention relevant to a Standard Activity?		Internal Funding Project #s:	
no			
If so, give details:			

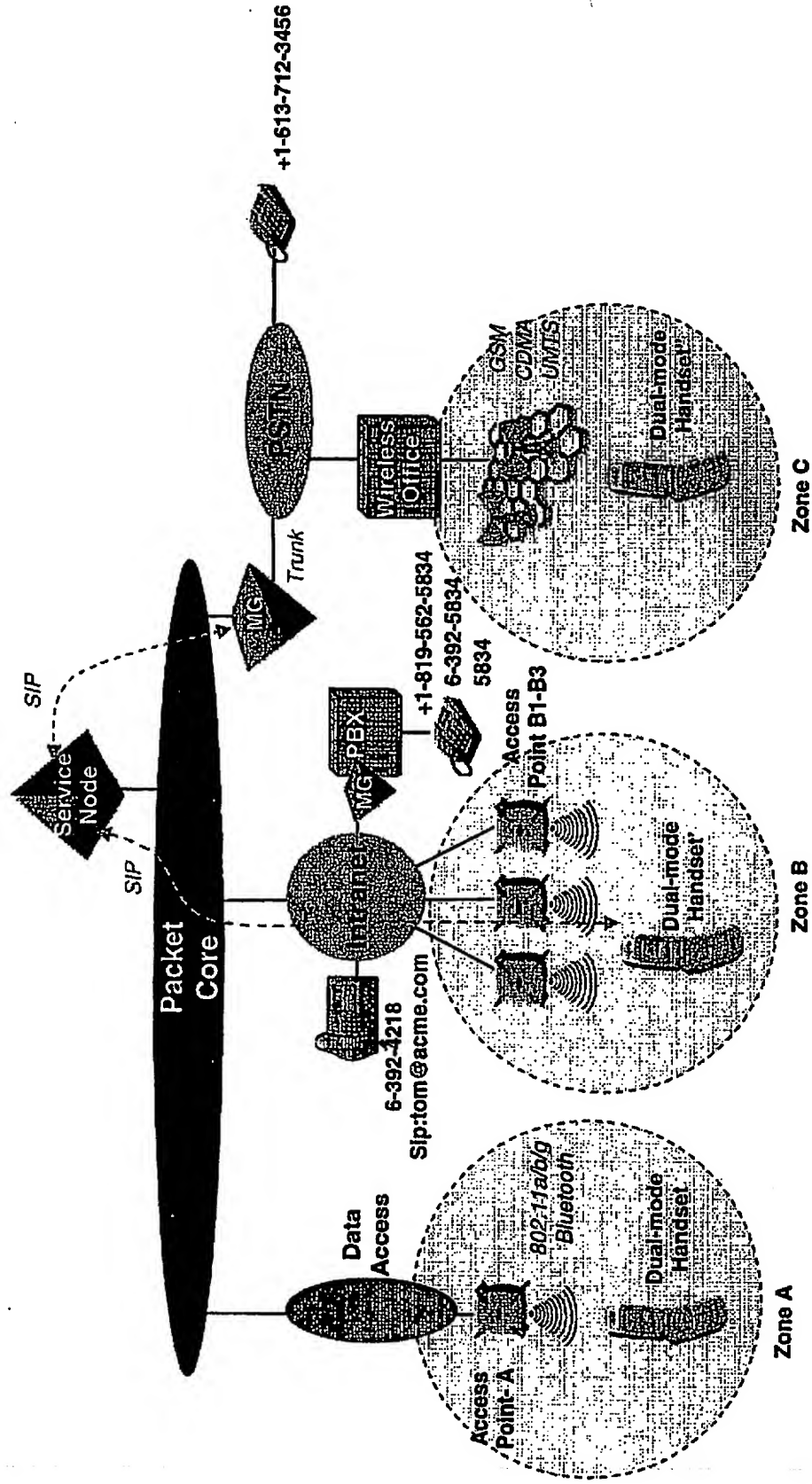
Technical Information	
Brief Description of the Invention:	
<ul style="list-style-type: none"> - Automatically selecting an address for a terminating party based on the originator network connectivity - Network connectivity is cellular network - Network connectivity is WLAN/Bluetooth network - Network connectivity is a specific WLAN/Bluetooth access point - Selection is done by specifying a terminating party name - Selection is one of multiple address entries for a terminating party - Address entry is one of <ul style="list-style-type: none"> public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, sip address, url address - Modifying the selected address based on originator network connectivity <ul style="list-style-type: none"> - Adding a prefix, removing a prefix - Substituting a portion of the address - Querying a service node for the public E.164 alias for a sip address entry, storing the public E.164 address in association with the sip address entry 	
Problem Solved by the Invention:	
<p>Dual mode handsets can initiate calls from various locations: cellular network, from an enterprise WLAN network, from home. Depending on those locations, the number that needs to be dialed will vary. A typical problem is the local personal directory for the handset contains entries for frequently dialed numbers. If the user is an enterprise user, the entries may contain the ESN number of colleagues or the 4-digit extension number. When dialing from the enterprise WLAN zone, the ESN or 4-digit number will work fine. However, if it's used on the cellular network these numbers won't work.</p> <p>To get around this issue, this invention proposes two options: store multiple entries for the user and let the handset automatically select the appropriate entry based on the current network connectivity. The second option consists in altering the stored number based on pre-established rules, such as translating an ESN number to a public number using a local map.</p> <p>A second problem solved is automating the process of retrieving an E.164 alias for a SIP address.</p>	
Solutions that have been tried and why they didn't work:	
<p>Modem dialers allow the selection of various prefix (e.g. 9) based on user location: users need to manually select the prefix; no address substitution or modification is done</p> <p>Multiple numbers can be stored in a personal directory for a same user: again the caller needs to select manually the entry.</p>	
Specific elements or steps that solved the problem and how they do it:	

See chart for some additional details

Commercial value of the invention to Nortel and Nortel's major competitors

This problem surfaced during the definition of the dual mode handset system solution (personal mobile communicator). This invention, although easy to implement, will significantly improve the usability of PMC, a critical factor for market acceptance. In addition, by automating the translation of sip addresses to E.164 aliases, this will also make it easier for users to start using sip addresses as the main address for users (the E.164 being the backup one), helping accelerating the transition to sip addresses, a more natural form of addressing for users.

Network



Rough claims

- **Automatically selecting an address for a terminating party based on the originator network connectivity**
 - Network connectivity is cellular network
 - Network connectivity is WLAN/Bluetooth network
 - Network connectivity is a specific WLAN/Bluetooth access point
- **Selection is done by specifying a terminating party name**
- **Selection is one of multiple address entries for a terminating party**
 - Address entry is one of public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, sip address, url address
- **Modifying the selected address based on originator network connectivity**
 - Adding a prefix, removing a prefix
 - Substituting a portion of the address
- **Querying a service node for the public E.164 alias for a sip address entry, storing the public E.164 address in association with the sip address entry**

Appendix B

Jennifer Alkove

From: Jennifer Alkove
Sent: Thursday, February 26, 2004 11:50 AM
To: 'sylvain@nortelnetworks.com'
Cc: Ben Withrow
Subject: First Draft of (our file 7000-341)



First Draft.zip (...)

Suspicious files were found in the attachments.

The file : First Draft.zip: Contains password-protected files

The original message follows:

Dear Dany:

Please find attached a first draft of the above-referenced patent application. The .zip file is protected with the password that we have used in previous applications. If you have any problems opening the attached file, please let me know. Please review the application and drawings carefully for accuracy and completeness, making any changes, additions, or corrections, if any, directly on the application (or electronically with changes tracked).

Please recall that the application must clearly explain the best mode of practicing the invention for which protection is desired. Also, the application must explain to an individual of ordinary skill in the art how to make and use the invention. After reviewing the application, please forward any comments to Ben Withrow and me. We will then send you a revised draft of the application, along with formal paperwork prepared for your signature. After receipt of the signed paperwork and approval from Nortel's legal department, we will file the application.

Please do not hesitate to contact Ben Withrow or me should you have any questions regarding the application. Thank you for allowing us to be of service to you and for your prompt attention to this matter.

Best regards,

Jennifer Rush Alkove

Withrow & Terranova, PLLC

201 Shannon Oaks Circle, Suite 200

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WARNING! This message may contain information that is confidential and/or protected under the attorney-client or other lawfully recognized privilege. If you received this message in error or through inappropriate means, please REPLY to this message to notify the Sender that the message erroneously was received by you, and then permanently delete this message from all storage media, without forwarding or retaining a copy.

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Version: 7.5.503 / Virus Database: 269.15.12/1097 - Release Date: 10/28/2007 1:58 PM

Appendix C

Nortel Case Status							
Updated							
Matter ID	First draft sent	First draft received back	Final draft sent (IP Law)	Final draft comments received back (IP Law)	Formal paperwork sent	Formal paperwork received back	Actual filing date (Prov.)
7000-3411	2/26/2004	3/12/2004	3/15/2004	4/13/2004	3/15/2004	3/19/2004	4/14/2004